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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,484	01/23/2004	Nausheen Moulana	MWS-107RCE2	7031
74321 7590 04/01/2009 LAHIVE & COCKFIELD, LLP/THE MATHWORKS FLOOR 30, SUITE 3000 One Post Office Square Boston, MA 02109-2127				
			EXAMINER ZEE, EDWARD	
			ART UNIT 2435	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,484

Applicant(s)

MOULANA ET AL.

Examiner

EDWARD ZEE

Art Unit

2435

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 12-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the amendments filed on January 15th, 2009. Claims 1-8, 10 and 12-24 are pending and have been considered below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 15th, 2009 has been entered.

Claim Objections

3. The amendments filed on January 15th, 2009 have been considered and are effective at overcoming the previous claim objections and thus have been withdrawn.

Drawings

4. **Figure 3** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 10, 12-17 and 20-22** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. **Claims 10, 12-17, 21 and 22** recite the limitation "*the optical medium*" throughout the claims. There is insufficient antecedent basis for this limitation in the claim.

The Examiner notes that independent Claim 10 recites at least "*an original optical medium*" and "*a protection program on an optical medium*" in lines 1 and 4 respectively.

Furthermore, the Examiner notes that Claim 21 recites at least "*a computer-readable optical medium*" and "*searching for a file on an optical medium*" in lines 1 and 8 respectively.

Additionally, the Examiner notes that Claim 22 recites at least "*a computer-readable optical medium*" and "*interacting with an optical medium*" in lines 1 and 2 respectively.

8. **Claim 20** recites the limitation "*the instructions*" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-8, 10 and 12-24 are rejected under 35 U.S.C. 102(e) as being anticipated by

Inokuchi et al. (2004/0133523).

Claim 1: Inokuchi et al. discloses a method of preventing use of an unauthorized copy of a software program residing on an optical medium, the method comprising:

a. providing a protection program(*ie. determining program*) on the optical medium, the protection program residing on the optical medium with the software program(*ie. software*), the protection program:

i. searching for a file on the optical medium prior to determining a media type of the optical medium, the file containing the software program(*ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted*) [page 8, paragraph 0155];

ii. determining the media type of the optical medium containing the software program(*ie. determines whether the loaded disc is an original or a copied disc*) [page 8, paragraph 0155];

iii. and inhibiting execution of the software program stored on the optical medium if: the file is missing on the optical medium, or the optical medium has media type that indicates that the optical medium is copied(*ie. when the disc is not an original disc, but a copied disc, access to the copied disc is restricted*) [page 8, paragraph 0155].

Claims 2 and 3: Inokuchi et al. discloses the method as in claim 1 above, and further discloses that the step of inhibiting the execution of the software program comprises preventing execution of selected features of the software program by determining a set of features of the software program to execute(*ie. selectively restrict only encrypted data, etc.*) [page 8, paragraph 0149].

Claim 4: Inokuchi et al. discloses the method as in claim 1, and further discloses that the step of inhibiting the execution of the software program comprises preventing execution of the software program(*ie. operation is cancelled*) [page 8, paragraph 0149].

Claim 5: Inokuchi et al. discloses the method as in claim 1 above, and further discloses that the step of determining the media type comprises inserting the optical medium in a drive of a computer and reviewing a medium-type code field contained in a mode parameter header of the optical medium(*ie. ATIP information such as writing characteristics, capacity, disc type, etc.*) [page 6, paragraph 0124].

Claim 6: Inokuchi et al. discloses the method as in claim 5, and further discloses that the drive is a CD-R/W drive [page 2, paragraph 0029].

Claim 7: Inokuchi et al. discloses the method as in claim 1 above, and further discloses that a media type indicates that the optical medium is copied is one of a write-once media type and an erasable/rewriteable media type [page 6, paragraph 0124].

Claim 8: Inokuchi et al. discloses the method as in claim 1 above, and further discloses the step of executing the software program stored on the optical medium if the step of determining determines the optical medium to be an optical read-only medium [page 7, paragraph 0145].

Claim 10: Inokuchi et al. discloses a method of authenticating an original optical medium, the method comprising:

a. accessing the optical medium in a compact disk-read/write (CD-R/W) drive coupled to a computer [page 2, paragraph 0029];

b. and identifying a protection program(*ie. determining program*) on an optical medium, the protection program:

i. searching for a file on the optical medium prior to checking a media type of the optical medium, the file containing a software program to be authenticated(*ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted*) [page 8, paragraph 0155];

ii. and checking the media type of the optical medium once the file has been located(*ie. determines whether the loaded disc is an original or a copied disc*) [page 8, paragraph 0155].

Claim 18: Inokuchi et al. discloses a method of preventing execution of an unauthorized copy of a software program stored on an optical medium, the method comprising:

a. identifying a protection program(*ie. determining program*) residing on the optical medium with the software program(*ie. software*), the protection program:

i. searching for a file on the optical medium containing the software program prior to determining a media type of the optical medium, the file containing the software program(*ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted*) [page 8, paragraph 0155];

ii. determining the media type of the optical medium(*ie. determines whether the loaded disc is an original or a copied disc*) [page 8, paragraph 0155];

iii. and executing the software program stored on the optical medium if: the file is included on the optical medium, and the optical medium has a media type that indicates that the optical medium is an original version(*ie. when the disc is not an original disc, but a copied disc, access to the copied disc is restricted*) [page 8, paragraph 0155].

Claims 21-23: The instant claims, as noted by Applicant, recite similar subject matter as claims 1, 10 and 18 above, and thus are rejected under similar rationale.

Claim 24: Inokuchi et al. discloses an electronic device comprising:

- a. a memory for storing computer program instructions [page 2, paragraph 0029];
- b. a processor for executing the stored computer program instructions [page 2, paragraph 0029];
- c. and a compact disk-read/write (CD-R/W) drive for receiving an optical medium containing a software program(*ie. software*) and a protection program(*ie. determining program*), the protection program including instructions for:

i. searching for a file on the optical medium containing the software program prior to determining a media type of the optical medium, the file containing the software program(*ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted*) [page 8, paragraph 0155];

ii. determining the media type of the optical medium(*ie. determines whether the loaded disc is an original or a copied disc*) and inhibiting execution of the software program stored on the optical medium if the file is missing on the optical medium or the optical medium has media type that indicates that the optical medium is copied(*ie. when the disc is not an original disc, but a copied disc, access to the copied disc is restricted*) [page 8, paragraph 0155].

Claim 12: Inokuchi et al. discloses the method as in claim 10 above, and further discloses that the step of checking a media type comprises reviewing a medium-type code field contained in a mode parameter header of the optical medium(*ie. TOC*) [page 6, paragraph 0120].

Claims 13-15: Inokuchi et al. discloses the method as in claim 10 above, and further discloses:

a. the step of checking the media type comprises verifying that the optical medium has a read-only media type and that it is indicative that the optical medium is an original version [page 7, paragraph 0145];

b. the step of executing a software program stored on the optical medium if the optical medium has a read-only media type [page 7, paragraph 0145].

Claim 16: Inokuchi et al. discloses the method as in claim 10 above, and further discloses that the step of checking the media type comprises identifying if the media type is one of a write-once media type and an erasable/rewritable media type [page 6, paragraph 0124].

Claim 17: Inokuchi et al. discloses the method as in claim 16 above, and further discloses the step of inhibiting execution of a software program stored on the optical medium if the step of checking identifies that the media type is one of a write-once media type and an erasable/rewritable optical media type [page 7, paragraph 0132].

Claim 19: Inokuchi et al. discloses the method as in claim 18 above, and further discloses that a read-only media type indicates that the optical medium is an original version [page 7, paragraph 0145].

Claim 20: Inokuchi et al. discloses the method as in claim 18 above, and further discloses the step of inhibiting execution of the instructions if the optical medium does not have a read-only media type [page 7, paragraph 0132].

Response to Arguments

11. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Whitten et al. (2003/0182574) discloses a similar invention of inhibiting execution of software on an optical medium by determining the media type [page 6, paragraph 0058].

Hirai (2004/0025024) also discloses a similar invention of inhibiting execution of software on an optical medium by determining the media type [page 7, paragraph 0101].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWARD ZEE whose telephone number is (571)270-1686. The examiner can normally be reached on Monday through Thursday 9:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EZ
March 22, 2009
/Kimyen Vu/
Supervisory Patent Examiner, Art Unit 2435